



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Abuin *et al.*

Group Art Unit: 1637

Application No.: 10/060,069

Examiner: T. E. Strzelecka

Filed: 01/29/02

Title: Novel Murine Polynucleotide Sequences
and Mutant Cells and Mutant Animals
Defined Thereby

Attorney Docket No.: LEX-0305-USA

#8 / A 58
6/26/03
RECEIVED
JUN 25 2003
TECH CENTER 1600/2900

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS

Commissioner for Patents
Alexandria, VA 22313

Sir:

The Examiner is respectfully requested to accept the following response to the Restriction and Election Requirement mailed April 15, 2003 (Paper No. 5), to consider the remarks therein.

A Petition for an Extension of Time of one month to and including June 15, 2003, which falls on a Sunday and is therefore extended until June 16, 2003 under 37 C.F.R. § 1.7, and authorization to deduct the fee as required under 37 C.F.R. § 1.17(a)(1) from Applicants' representatives Deposit Account are included. The response is thus timely filed. Applicants believe no fees in addition to the fee for the extension of time are due in connection with this response. However, the Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-0892.

AMENDMENT

In the claims:

Please cancel claims 1-7 and 9, entirely without prejudice and without disclaimer, as drawn to non-elected inventions.

Please amend claim 8 so that the text of the amended claims reads as follows:

8. (Amended) An isolated murine embryonic stem cell line comprising an engineered mutation
in at least one gene comprising a polynucleotide sequence first disclosed in one of SEQ ID NOS: 705.

A1

RESPONSE

I. Restriction Requirement

The Examiner has determined that the original claims are directed to five separate and distinct inventions under 35 U.S.C. § 121, as follows:

- Group I: Claims 1 and 2, drawn to an isolated polynucleotide comprising at least 60 nucleotides of SEQ ID NO: 1-1, 206, classified in class 536, subclass 23.1, for example..
- Group II: Claims 3-6, drawn to a process for producing an isolated polynucleotide comprising hybridization of a probe to a template, classified in class 435, subclass 6, for example.
- Group III: Claim 7, drawn to a process for identifying novel polynucleotide sequences by comparing sequences of polynucleotides with SEQ ID NO 1-1,206 with a test polynucleotide sequence, classified in class 536, subclass 23.1, for example.
- Group IV: Class 8, drawn to an isolated murine stem cell line comprising a mutation in at least one gene comprising polynucleotides with SEQ ID NO 1-1,206, classified in class 435, subclass 325, for example.
- Group V: Claim 9, drawn to a method of generating a high affinity antibody to a human protein, classified in class 530, subclass 387.1, for example

II. Response to Restriction Requirement

In response to the Restriction Requirement mailed April 15, 2003 (Paper No. 5), Applicants hereby elect without traverse to prosecute the claim of Group IV (Claim 8), drawn to an isolated murine stem cell line comprising a mutation in at least one gene comprising a polynucleotides with SEQ ID NO 1-1,206, classified in class 435, subclass 325, for example. Accordingly, Claims 1-7 and 9 are cancelled without disclaimer and without prejudice as drawn to non-elected inventions. Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority applications.

The Applicants' provisionally elect SEQ ID NO:705 for searching purposes. However, the

provisional election of SEQ ID NO: 705 is made with traverse since all of the mutated cell lines grouped in original Claim 8 share the structural feature of having been mutated by the mutational insertion of a common genetically engineered vector.

III. Status of the Claims

Claims 1-7 and 9, representing the Group I, II, III, and V inventions, respectively, have been cancelled without prejudice or disclaimer as drawn to non-elected inventions.

No claim within the Group IV invention has been cancelled. In order to better define the invention of the elected Group IV, the claim presently within the Group IV invention has been amended.

Claim 8 is thus presently pending in the case. In compliance with 37 C.F.R. § 1.121(c)(1)(ii), a marked up copy of the original claims is attached hereto as Exhibit A. For the convenience of the Examiner, a clean copy of the pending claims is attached hereto as Exhibit B.

IV. Support for the Claims

Support for amended Claim 8 can be found in the claim as originally filed, and, inter alia, in the Sequence Listing. Accordingly, the present amendment is not deemed to constitute new matter.

V. Conclusion

The present document is a complete response to the Restriction and Species Election Requirement. Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested. Should Examiner Strzelecka have any questions or comments, or believe that certain amendments of the claims might serve to improve their clarity, a telephone call to the undersigned Applicants' representative is earnestly solicited.

Respectfully submitted,



06/16/03
Date

Lance K. Ishimoto

Reg. No. 41,866

LEXICON GENETICS INCORPORATED
(281) 863-3333

